

REMARKS

Applicant respectfully requests allowance of the subject application. Claims 1-50 are pending. Claims 4, 8, 12, 14, 16, 17, and 44 have been amended. In view of the following remarks, Applicant respectfully requests that the rejections be withdrawn and the application be forwarded along to issuance.

Claim Objections

The Examiner objected to Claims 4, 12, 42, and 44 citing typographical errors. Claims 4, 12, and 44 have been amended to correct those errors. As for Claim 42, the Examiner objected to the phrase "the defining." That phrase is not found in Claim 42, so the Examiner's basis for rejecting 42 is improper. The phrase "the defining" was, however, found and corrected in Claim 44.

§112 Rejections

The rejected Claims 8, 16, and 17 noting a lack of antecedent basis for various claim elements. Claims 8, 16, and 17 have been amended to address the Examiner's concerns.

§101 Rejections

The Examiner rejected Claims 1-8, 20-34, 41-42, and 47-48 under 35 USC § 101. That section provides that inventors of new and useful processes, machines, manufactures, and compositions of matter can obtain patents. In other words statutory subject matter includes new and useful processes, machines, manufactures, and compositions of matter. Certain items fall in the category of non-statutory subject matter such as laws of nature and other abstract ideas that constitute descriptive material. MPEP 2106(IV)(B)(1).

Claims 1-8, 41, and 42: Claim 1 is directed to a method or process while each of Claims 2-8, 41, and 23 depend ultimately from Claim 1. Without citing the MPEP for support, the Examiner rejected these claims simply stating that the bodies of those claims are "merely abstract idea[s] . . . being processed without any links to a practical result in the technology arts and without computer manipulation." The Examiner objects that the

claims "recite 'a method' and do not contain a computer that is used to implement the method so as to realize its functionality."

There is no requirement that a process claim recite a structure such as a computer. To the contrary, a "claim that requires one or more acts to be performed defines a process." MPEP 2106(IV)(B)(2)(b). To be statutory

a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts

MPEP 2106(IV)(B)(2)(b). As for option (B) a process is statutory where it produces a concrete, tangible, and useful result. MPEP 2106(IV)(B)(2)(b). As examples, a processes that calculates a n algorithm that models noise is not statutory, but a process for digitally filtering the noise that employs such an algorithm is statutory. MPEP 2106(IV)(B)(2)(b).

Claim 1 satisfies option (B) in that it produces a concrete, tangible, and useful result. Claim 1 includes the following acts:

- providing a readable resource;
- defining a human-readable resource designator associated with the readable resource;
- defining a computer-readable resource designator associated with the human-readable resource designator and that can be used by a computer to automatically access the readable resource; and
- forming, on the readable resource, the human-readable resource designator and the computer-readable resource designator, the computer-readable resource designator comprising means for the computer to confirm that the computer readable resource designator can be used to access the readable resource helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that might appear on the readable resource.

The acts of defining the human readable and computer readable resource designators and then forming those designators on a readable resource in the manner prescribed produces a concrete, tangible, and useful result akin to the noise filtering example above.

For these reasons, claims 1-8, 41, and 42 are felt to define statutory subject matter. Should the Examiner persist, the Applicant requests that the Examiner cite support in the MPEP or otherwise for the Examiner's assertion that a method or process

claim is not statutory if it does not "contain a computer that is utilized to implement the method so as to realize its functionality."

Claims 20-34, 47, and 48: Without citing a reference for support, the Examiner rejected Claims 20-34, 47, and 48 stating that the claims recite a system but do not "contain a computer that is used implemented the system so as to realize" functionality. The Examiner then concludes that the bodies of the claims are "merely abstract ideas and [are] being processed without any links to a practical result in the technology arts and without computer manipulation."

Claims 20-34, 47, and 48 are felt to define statutory subject matter as there is no requirement under Title 35 of the US Code, in the regulations, or in the MPEP that a system include a computer to implement the system for a claim to be statutory. Should the Examiner persist, the Applicant respectfully requests that the Examiner cite support in the MPEP or otherwise for the Examiner's assertion that a system claim is not statutory if it does not include a computer to implement the system.

§103 Rejections

Claims 1-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,076,733 to Wilz, et al. (hereinafter "Wilz") in view of U.S. Patent No. 6,542,933 to Durst (hereinafter "Durst").

Claim 1 recites a method comprising:

- providing a readable resource;
- defining a human-readable resource designator associated with the readable resource;
- defining a computer-readable resource designator associated with the human-readable resource designator and that can be used by a computer to automatically access the readable resource; and
- forming, on the readable resource, the human-readable resource designator and the computer-readable resource designator, the computer-readable resource designator comprising means for the computer to confirm that the computer readable resource designator can be used to access the readable resource helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that might appear on the readable resource.

In short, Claim 1 requires forming a computer readable resource designator on a readable resource where the computer readable resource designator can be used to access *that particular* readable resource. Moreover, the computer readable resource designator must include a means for a computer to confirm that the designator can be used to access the readable resource.

The Examiner asserts that Wilz teaches the first three limitations above and that Wilz and Durst teach the fourth limitation. The teachings of Wilz are summarized in Wilz Fig. 1A. That figure illustrates a readable resource in the form of a Web-site Directory (13) showing several URL encoded bar codes (8), human readable URLs (14), and content descriptions corresponding to each URL. Each bar code (8) can be scanned to access a web page (distinct from the readable resource (13) itself) described by the content description for that web page. Not one of the bar codes (8) is encoded with an URL that can be used to access the readable resource (13). As such, Wilz does not teach defining a computer-readable resource designator that can be used by a computer to automatically access the readable resource and then forming that computer readable resource designator on that readable resource in the manner required by Claim 1.

The Examiner asserts that Wilz, Fig. 6B and Wilz, col. 3, lines 7-14 teach the third limitation requiring that the defined computer readable resource designator be formed on the readable resource. As noted above, the computer readable resource designator referred to has been defined so that it can be used by a computer to automatically access the readable resource on which it is formed. Wilz, col. 3, lines 7-14 provide the following:

A further object of the present invention is to provide such an Internet Access System, wherein the URL-encoded bar code symbol printed on various types of print media is a URL-encoded truncated-type bar code symbol, having a very low height to length ratio, thereby allowing many URL-encoded bar code symbols to be printed on a single sheet or page of a Web-site guide, along with their corresponding human-readable URLs and content descriptions.

The cited section describes using a low profile format for an URL encoded bar code so that multiple bar codes can be fitted on a "Web-site guide." A web-site guide or directory, as noted above is simply a guide to a plurality of different web sites that are distinct from the guide itself (as it simply does not make sense for a web site

guide to refer to itself). The cited section mentions nothing of forming an URL encoded bar code on a web guide where that encoded URL is for accessing the web guide.

Wilz, Fig. 6B, reproduced below, represents more of the same.

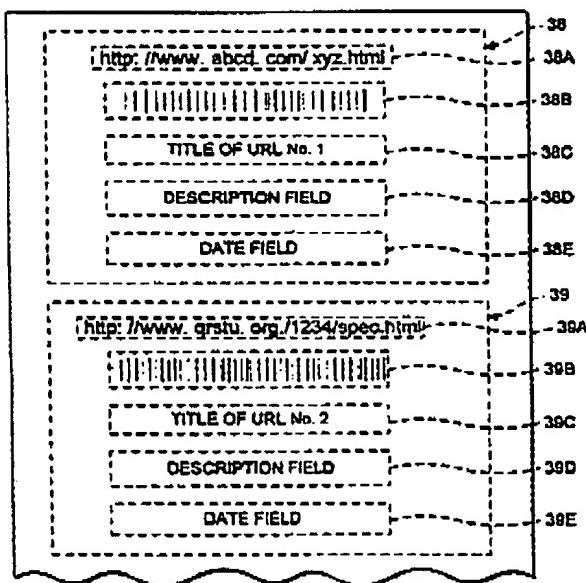


FIG. 6B

Fig. 6B illustrates an URL encoded menu that includes information blocks (38 and 39). Each block is associated with a particular web site or readable resource. Field 38A contains an URL for the web site. Field 38B contains a bar code encoded with that URL. Fields 38C-38E provide further description of the web site. Wilz, col. 22, lines 17-46. Plainly, Barcodes in fields 38B and 39B are not encoded with URLs for accessing the menu of Fig. 6B. As such, Fig. 6B does not teach forming a computer readable recourse designator (URL encoded bar code) on the readable resource where the computer readable recourse designator (URL encoded bar code) is defined to accessing the readable resource on which it is formed.

The Examiner admits that Wilz fails to teach that the computer readable resource designator include "means for the computer to confirm that the computer readable resource designator can be used to access the readable resource" – as required in the fourth limitation above. Instead, the Examiner relies on Durst. Durst teaches using a barcode to encode encrypted symbol data and an unencrypted or "clear" checksum. Durst, col. 4, line 59 through col. 5, line 12. The barcode is

S/N: 09/898.792

printed on a document such as a brochure, magazine insert or page, an envelope, or a memo. Durst, col. 4, lines 51-58; col. 6, line 55 through col. 7, line 3. The symbol data includes an URL for accessing electronic data from a database. Durst, col. 4, lines 51-58. The barcode is scanned to identify the clear checksum and the encrypted symbol data. The clear checksum is used to decrypt the symbol data which is then used to calculate a checksum. Durst, col. 7, lines 4-23. The clear checksum and the calculated checksum are compared. Durst, col. 7, lines 23-27. If they match the URL from the symbol data is used to access the electronic data. Durst, col. 7, lines 37-34.

In short, Durst teaches the use of a checksum in combination with a printed bar code to verify that the bar code encodes an URL that has been associated with the checksum. Durst does *not* teach or even suggest that the bar code include or otherwise use a checksum to confirm that a barcode formed on a readable resource can be used to access *that same* readable resource in the manner required by Claim 1.

For at least these reasons, a *prima facie* case for obviousness has not been established, and Claim 1 distinguishes over Wilz in view of Durst.

Claims 2-8, 41, and 42 depend either directly or indirectly from Claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claim 9 recites one or more computer-readable media having computer-readable instructions thereon which, when executed by one or more processors, cause the one or more processors to:

- define a human-readable resource designator comprising a URL that can be used to access a Web page;
- define a computer-readable resource designator associated with and corresponding to the URL that can be used by a computer to automatically access said Web page; and

- form the human-readable resource designator with the computer-readable resource designator in a manner such that when the Web page is printed, the human-readable and computer readable designators appear thereon wherein the computer-readable resource designator comprises means for a computer to confirm that the computer readable resource designator can be used to access the Web page helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that might appear on the Web page.

In short, Claim 9 requires instruction for forming a computer readable resource designator on a printed Web page where the computer readable resource designator can be used to access *that same* Web page. As made clear above, Wilz both alone and in combination with Durst fails to teach or suggest forming a computer readable resource designator on a web page or any other readable resource where that designator can be used to access the web page. Moreover, neither Wilz nor Durst teaches or suggests defining a computer-readable resource designator where that designator includes "means for a computer to confirm that the computer readable resource designator can be used to access the Web page" on which the designator has been formed.

Accordingly, for at least these reasons, a *prima facie* case for obviousness has not been established, and Claim 9 distinguishes over Wilz in view of Durst.

Claims 10-13, 43, and 44 depend either directly or indirectly from claim 9 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 9, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claim 14 has been amended and, as amended recites a method comprising:

- reading, with a computer, a computer-readable resource designator displayed on a readable resource and displayed in conjunction with a human-readable resource designator that can be read by a human and used to access the readable resource;
- confirming that the computer readable resource designator can be used to automatically access the readable resource helping to prevent said computer-readable resource designator from being confused with

other computer-readable resource designators that might appear on the readable resource;

- processing the computer-readable resource designator to identify a network-accessible resource;
- requesting the readable resource from the network-accessible resource; and
- receiving the readable resource.

In short, Claim 14 requires reading a computer readable designator displayed on a readable resource, confirming that the designator can be used to access the readable resource, requesting and receiving the readable resource. Neither Wilz nor Durst discloses nor suggests a method in which a computer-readable resource designator is read where that designator is displayed on a readable resource and later processed to request and ultimately receive *that same* readable resource. Moreover, neither Wilz nor Durst teach or suggest confirming that the computer readable resource designator can be used to automatically access *the same* readable resource on which it is displayed.

The Examiner admits that Wilz does not teach the act of confirming listed above. Instead, the Examiner relies on Durst. Durst teaches using a barcode to encode encrypted symbol data and an unencrypted or "clear" checksum. Durst, col. 4, line 59 through col. 5, line 12. The barcode is printed on a document such as a brochure, magazine insert or page, an envelope, or a memo. Durst, col. 4, lines 51-58; col. 6, line 55 through col. 7, line 3. The symbol data includes an URL for accessing electronic data from a database. Durst, col. 4, lines 51-58. The barcode is scanned to identify the clear checksum and the encrypted symbol data. The clear checksum is used to decrypt the symbol data which is then used to calculate a checksum. Durst, col. 7, lines 4-23. The clear checksum and the calculated checksum are compared. Durst, col. 7, lines 23-27. If they match the URL from the symbol data is used to access the electronic data. Durst, col. 7, lines 37-34.

In short, Durst teaches the use of a checksum in combination with a printed bar code to verify that the bar code encodes an URL that has been associated with the checksum. Durst does *not* teach or even suggest using a checksum to confirm

that a barcode displayed on a readable resource can be used to access *that same* readable resource in the manner required by Claim 14.

Accordingly, for at least these reasons, a *prima facie* case for obviousness has not been established, and Claim 14 distinguishes over Wilz in view of Durst.

Claims 15-19, 45, and 46 depend either directly or indirectly from claim 14 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 14, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claim 20 recites a system, comprising:

- a readable resource;
- a human-readable resource designator on the readable resource, said human readable resource designator being associated with the readable resource; and
- a computer-readable resource designator on the readable resource, said computer-readable resource designator being useable to access the readable resource;
- the computer-readable resource designator being associated with and corresponding to the human-readable resource designator;
- the computer-readable resource designator being configured for use by a computer so that a computer can automatically retrieve the readable resource and the computer readable resource designator comprising means for the computer to confirm that the computer readable resource designator can be used to retrieve the readable resource helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that might appear on the readable resource that can be used by the computer to access other resources not associated with both the human-readable resource designator and the computer-readable resource designator.

In short, Claim 20 requires a computer readable resource designator on a readable resource where the designator can be used by a computer to access the readable resource. As made clear above, Wilz both alone and in combination with Durst fails to teach or suggest a computer readable resource designator on a web page or any other readable resource where that designator can be used to access

the readable resource. Moreover, neither Wilz nor Durst teaches or suggests a computer-readable resource designator on a readable resource where that designator includes "means for the computer to confirm that the computer readable resource designator can be used to retrieve the readable resource" on which the designator has been formed – as opposed to a designator that can be used to access a different readable resource.

Accordingly, for at least these reasons, a prima facie case for obviousness has not been established, and Claim 20 distinguishes over Wilz in view of Durst.

Claims 21-29, 47, and 48 depend either directly or indirectly from claim 20 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 20, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claim 30 recites a system, comprising:

- a human-readable resource designator formed on a readable resource and associated with the readable resource; and
- a computer-readable resource designator formed on the readable resource and associated with and corresponding to said human-readable resource designator, the computer-readable resource designator being configured for use by a computer so that a computer can automatically retrieve the readable resource, said computer-readable resource designator comprising means for the computer to confirm that the computer readable resource designator can be used to access said readable resource helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that may be formed on the readable resource.

Similar to the other claims above, Claim 30 requires a computer readable resource designator formed on a readable resource where the designator can be used to automatically access the readable resource. As made clear above, Wilz both alone and in combination with Durst fails to teach or suggest a computer readable resource designator on a web page or any other readable resource where that designator can be used to access that readable resource. Moreover, neither Wilz nor Durst teaches or suggests a computer-readable resource designator where

that designator includes "means for the computer to confirm that the computer readable resource designator can be used to access said readable resource" on which the designator has been formed – as opposed to a designator that can be used to access a different readable resource.

Accordingly, for at least these reasons, a prima facie case for obviousness has not been established, and Claim 30 distinguishes over Wilz in view of Durst.

Claims 31-34 depend directly claim 30 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 30, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claim 35 recites a system, comprising:

- a readable resource on which a human-readable resource designator and a computer-readable resource designator associated with and corresponding to the human-readable resource designator have been formed;
- the computer-readable resource designator being configured for use by a computer so that a computer can automatically retrieve the readable resource, the computer readable resource designator comprising means for the computer to confirm that the computer readable resource designator can be used to retrieve the readable resource helping to prevent said computer-readable resource designator from being confused with other computer-readable resource designators that might appear on the readable resource;
- a server configured to receive requests from the computer for an electronic version of the readable resource associated with both the human-readable resource designator and the computer-readable resource designator, and return the readable resource to the computer; and
- a data store for holding the electronic version of the readable resource that can be requested by the computer.

Similar to the other claims above, Claim 35 requires a readable resource on which a computer readable resource designator has been formed where the computer readable resource designator can be used by a computer to automatically retrieve an electronic version of the readable resource. As made clear above, Wilz both alone and in combination with Durst fails to teach or suggest a computer

readable resource designator on a web page or any other readable resource where that designator can be used to access that readable resource. Moreover, neither Wilz nor Durst teaches or suggests a computer-readable resource designator where that designator includes "means for the computer to confirm that the computer readable resource designator can be used to retrieve the readable resource" on which the designator has been formed – as opposed to a designator that can be used to access a different readable resource.

Accordingly, for at least these reasons, a prima facie case for obviousness has not been established, and Claim 35 distinguishes over Wilz in view of Durst.

Claims 36-40, 49 and 50 depend either directly or indirectly from claim 35 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 35, are neither shown nor suggested in the references of record, either singly or in combination with one another.

CONCLUSION

Claims 1-50 are felt to be in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

Guy L. Burnham

By



Jack H. McKinney
Reg. No. 45,685

April 27, 2005